



IFN 3635

PTO/SB/17 (12-04)
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Effective on 12/08/2004.
Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).

FEE TRANSMITTAL

For FY 2005

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$) 130.00

Complete if Known

| | |
|----------------------|------------------|
| Application Number | 09/245,720 |
| Filing Date | February 8, 1999 |
| First Named Inventor | Bunichi SHOJI |
| Examiner Name | Chi Q. Nguyen |
| Art Unit | 3635 |
| Attorney Docket No. | 037227.47565US |

METHOD OF PAYMENT (check all that apply)

☐ Check ☒ Credit Card ☐ Money Order ☐ None ☐ Other (please identify):
☒ Deposit Account Deposit Account Number: **05-1323 (Docket No. 037227.47565)** Deposit Account Name: **23911**
For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)
☐ Charge fee(s) indicated below ☐ Charge fee(s) indicated below, except for the filing fee
☒ Charge any additional fee(s) or underpayments of fee(s) ☒ Credit any overpayments
under 37 CFR 1.16 and 1.17

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

FEE CALCULATION

1. BASIC FILING, SEARCH, AND EXAMINATION FEES

| Application Type | FILING FEES | | SEARCH FEES | | EXAMINATION FEES | | Fees Paid (\$) |
|------------------|-------------|--------------|-------------|--------------|------------------|--------------|----------------|
| | Fee (\$) | Small Entity | Fee (\$) | Small Entity | Fee (\$) | Small Entity | |
| Utility | 300 | 150 | 500 | 250 | 200 | 100 | |
| Design | 200 | 100 | 100 | 50 | 130 | 65 | |
| Plant | 200 | 100 | 300 | 150 | 160 | 80 | |
| Reissue | 300 | 150 | 500 | 250 | 600 | 300 | |
| Provisional | 200 | 100 | 0 | 0 | 0 | 0 | |

2. EXCESS CLAIM FEES

| Fee Description | Fee (\$) | Small Entity |
|---|----------|--------------|
| Each claim over 20 or, for Reissues, each claim over 20 and more than in the original patent | 50 | 25 |
| Each independent claim over 3 or, for Reissues, each independent claim more than in the original patent | 200 | 100 |
| Multiple dependent claims | 360 | 180 |
| Total Claims | | |
| - 20 or HP | x | = |
| HP = highest number of total claims paid for, if greater than 20 | | |
| Indep. Claims | | |
| - 3 or HP | x | = |
| HP = highest number of total claims paid for, if greater than 3 | | |

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper, the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

| Total Sheets | Extra Sheets | Number of each additional 50 or fraction thereof | Fee (\$) | Fee Paid (\$) |
|--------------|--------------|--|----------|---------------|
| - 100 = | / 50 = | Round up to a whole number x | = | |

4. OTHER FEES

| | Fee Paid (\$) |
|---|---------------|
| Non-English Specification, \$130 fee (no small entity discount) | |
| Other: Petition Fee | \$130.00 |

SUBMITTED BY

| | | |
|-------------------|------------------|-----------------------|
| Signature | Registration No. | Telephone |
| Name (Print/Type) | (Attorney/Agent) | |
| James F. McKeown | 25,406 | (202) 624-2500 |
| | | Date January 24, 2006 |

This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 09/245,720 Confirmation No. : 5294
First Named Inventor : Bunichi SHOJI
Filed : February 8, 1999
TC/A.U. : 3635
Examiner : Chi Q. Nguyen

Docket No. : 037227.47565
Customer No. : 23911

Title : A Truss Structure, Structural Members Thereof, and a
Method of Manufacture Therefor

PETITION TO WITHDRAW NOTICE OF ABANDONMENT

Mail Stop PETITION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant, by and through his undersigned attorney, respectfully petitions the Honorable Commissioner of Patents to withdraw the Notice of Abandonment mailed January 13, 2006, on grounds that it is arbitrary, capricious and without basis in law, regulation or fact.

Exceptional cause exists for the granting of this petition in light of applicant's several and good faith attempts to address a general and ambiguous objection to the drawings, which objection and its solution have never been articulated. The Examiner has undertaken this arbitrary and capricious action notwithstanding the allowability of the claimed subject matter as well as the fact that applicant has received a Letters Patent on his related divisional case (attached U.S. Patent 6,604,401B2) where the Examiner in charge of that application found no similar defect. Thus, the action by the Examiner in the

instant case is seen to clearly to violate the general rule against the divestiture of valuable property rights absent exceptional circumstances.

Applicant has never been able to ascertain from the Examiner what the factual basis for the drawing objection is. In the initial Office Action on the merits mailed January 17, 2002, already indicating allowable subject matter, the Examiner objected to the drawings on the following ground, which is the very same ground leading to the just-issued Notice of Abandonment:

The drawings are objected to under 37 CFR §1.83(a) because they fail to show the interconnection of the parent plate to the chord members as described in the specification. Any structural detail that is essential for a proper understanding of the invention should be shown in the drawing. MPEP §608.02(d).

* * *

Two things should be noted in this regard. First, no assertion was made that the alleged missing interconnection acknowledged to have been described as a claimed feature. Second, no effort was made, particularly given the simplicity of the technology to which the present invention relates, to explicate why one of ordinary skill in the art would not have understood how the invention was made and used, or why such a structural detail was so essential.

In light of the lack of any explanation, applicant requested reconsideration in its timely Reply filed on May 17, 2002. In this connection, attention is directed to the paragraph bridging pages 3 and 4 of that paper. The following

Office Action mailed September 25, 2002, indicated that the drawing had been accepted (see PTO-326). Thereafter, on December 26, 2002, applicant submitting proposed drawing changes for Figures 1, 4, 5, 6 and 8 to correspond with changes on the Substitute Specification. These propose changes were not directed to the objections initially raised but withdrawn. On April 4, 2003, an Office Action was mailed acknowledging the communication of December 26, 2002, but in which, once against, the original drawings were indicated as approved but no reference was made to the proposed drawing changes (see PTO-326).

In order to place the case in condition for allowance, applicant timely filed a Reply on June 24, 2003, inviting the Examiner to contact the undersigned to address any remaining minor concerns about claim language. Thereafter, a final rejection was mailed on September 2, 2003, dealing solely with a Section 112, second paragraph, issue. No drawing objection was raised. In response thereto, applicant timely filed a Reply on October 10, 2003, with the hope that all issues could be resolved quickly given their nature.

Then followed another but non-final Office Action mailed November 13, 2003, without any reference to the drawings but now raising a prior art rejection under 35 USC §102(b) to which applicant timely replied on February 13, 2004, with some additional drawing change requests to Figs. 3, 4 and 5, primarily to eliminate textual material on those figures.

On May 17, 2004, a final rejection was mailed, again raising a rejection under 35 USC §102(b), but specifically acknowledging the request for drawing changes without objection. In response thereto, applicant timely submitted proposed amendments to Claims 1, 2, 9 and 10 on August 12, 2004, in addition to having been, by circumstances, compelled to file a Notice of Appeal. Thereupon, a Quayle Office Action was mailed on October 18, 2004, allowing the remaining claims, but raising the following drawing objection.

The drawings are objected to because Figures 1 and 2 show a schematic relationship of the truss structure. Figures 3 and 6-8 show details of various joints. However, there are no drawing figures that tie the details in Figures 3 and 6-8 to the schematic. There are no common reference numbers between the two sets of drawings[,] and the location of the components in figures 3 and 6-8 is not clear for the general layout of the truss.

Notwithstanding the fact that one of ordinary skill of in this art would not have found anything objectionable to the schematic truss showing on Figures 1 and 2 or have had any real difficulty in relating that structure to the joints shown Figures 3 and 6-8, applicant proposed further drawing changes on December 21, 2004, to "tie" the numerals in Figures 3 and 6-8 with those on Figures 1 and 2, again given the fact that no further exercise was called for.

Instead of, at that point and more than two years of prosecution, more specifically articulating the objections, the Examiner issued a Notice of Non-Compliant Amendment on July 5, 2005, to which the applicant soon responded with his paper filed July 28, 2005, containing an explanation deemed suitable to

address the question raised in said Notice. Again, the Examiner was invited to have a telephone discussion to address any remaining issue.

Yet another communication was issued on October 17, 2005, appearing to suggest the need for an additional drawing figure which "ties the details of Figures 1-2 to the details of Figures 3 and 6-8." This suggestion was particularly ambiguous in light of the original acknowledgement by the Examiner that Figures 1 and 2 were schematic showings of the truss and did not show details. Nevertheless, applicant was being called upon, so it seems, to provide a new drawing figure "tying" non-existent details in Figs. 1 and 2 with the joint structure in Figures 3 and 6-8, thereby all but ignoring the earlier requirement that common reference numbers be used (something that was done in the papers filed December 20, 2004 and November 2, 2004).

The pending Notice of Abandonment now refers to a requirement of detailed "relations" of Figures 1 and 2 with Figures 3 and 6-8. Beyond the earlier specific reference to the need for common reference numerals and satisfied, however, the Examiner has, against fairness and equity, held this otherwise allowable case abandoned on pretextual grounds without any sound factual reasoning or legal basis while needlessly prolonging prosecution, and wasting of patent term and needless resources of the PTO and applicant.

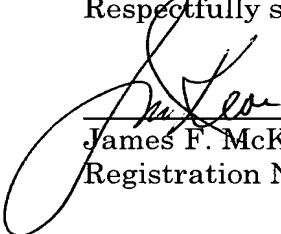
Therefore, it is respectfully and urgently requested that the Notice of Abandonment be withdrawn and the case be processed for issuance as a Letters Patent.

If there are any questions regarding this petition or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

Please charge any deficiency in fees or credit any overpayments to Deposit Account No. 05-1323 (Docket #037227.47565).

Respectfully submitted,

January 24, 2006



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